

REMARKS

Prior to this amendment, Claims 1-31 were pending in the application and have been rejected. After entry of this amendment, Claims 1-36 are pending.

Amendments

Claims 1, 4, 7, and 8 have been amended to delete the term "ethylsulfide" therefrom.

Claim 1 has also been amended to define the steroid or a derivative thereof as being selected from the group consisting of tomatidine and demissidine. Antecedent basis for this claim is located at page 3, lines 1-3.

Claims additionally have been amended to correct obvious minor errors.

New claims 32-35 present dependent claims that define the sulfide group of R³ to be ethylsulfide. Antecedent basis for this claim is located in original claims 1, 4, 7 and 8.

New claim 36 describes a method generally as described in original claim 1, except that the claims are limited to the steroid modified solatriose of the general formula (Ib).

Claim Rejections – 35 USC § 112

Claims 1-31 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 have been rejected as not reciting all the process steps leading to the intended products Ia or Ib.

It is respectfully submitted that the present claims describe key portions of the reaction scheme, relative to patentability. Other portions of this reaction scheme do not need to be recited, because the skilled artisan can readily determine the step before and after the recited steps in order to make the end product from the description provided in the present specification in combination with their knowledge of chemical processes. The present claim format thus recites only the portion relevant in determining patentability for this aspect of the invention. By use of this format, the invention is described concisely, and it is submitted that the scope of the claim is more clear than if all reaction steps were cited.

Claim 1 has been objected to for the simultaneous use of the terms “ethylsulfide” or “a sulfide group” as definitions in the term R^3 . Ethylsulfide is a specific example of a sulfide group. The term “ethylsulfide” has been deleted from claims 1, 4, 7, and 8.

Reconsideration and withdrawal of the outstanding formal rejections is therefore requested in view of the foregoing.

Claim Rejections – 35 USC § 102

Claims 25, 27 and 29 have been rejected under 35 U.S.C. 102(b) as being anticipated by Li et al (Carbohydrate Research, 2001, 331, 1-7).

Li discloses a protected chacotriose of the steroid diosgenin as compound 15 on page 2. Claim 1 has been amended to define the steroid of the present claims to be selected from the group consisting of tomatidine and demissidine. It is respectfully submitted that the present claims are not anticipated by Li.

Claims 1-5 and 10-18 have been rejected under 35 U.S.C. 102(e) as being anticipated by Shahid (WO 03/018604).

Claim 30 has been rejected under 35 U.S.C. 102(e) as being anticipated by Shahid (WO 03/018604).

Shahid describes a reaction scheme for preparation of the chacotriose of solasodine.

Claim 1 has been amended to define the steroid of the present claims to be selected from the group consisting of tomatidine and demissidine.

New claim 36 additionally is presented, and describes a method generally as described in original claim 1, except that the claims are limited to the steroid modified solatriose of the general formula (Ib).

It is respectfully submitted that the claims as amended do not recite a reaction scheme for preparation of the chacotriose of solasodine. Reconsideration and withdrawal of the outstanding rejection of the claims as being anticipated is therefore requested in view of the foregoing.

STATEMENT REGARDING COMMON OWNERSHIP

Applicant hereby states that at the time the presently claimed invention was made, both the subject matter of Shahid (WO 03/018604) and of the present invention were owned by the same person or subject to an obligation of assignment to the same person.

Claim Rejections – 35 USC § 103

Claims 1-5, 10-24, 26, 28, 30 and 31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shahid (WO 03/018604).

Claims 6-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shahid (WO 03/018604) in view of Tamura (Trends in Glycoscience and Glycotechnology, 2001, 13(69), pages 65-88).

The primary reference, Shahid, qualifies as prior art only under 35 U.S.C. 102(e).

As noted on the face of Shahid, the reference as assigned to Glycomed Sciences Limited. Applicants have conducted a review, and confirmed that at the time the presently claimed invention was made, both the subject matter of Shahid (WO 03/018604) and of the present invention were owned by the same person or subject to an obligation of assignment to the same person. Applicants therefore have authorized the above Statement Regarding Common Ownership.

Because the primary reference of the rejections under 35 U.S.C. 103(a) is not available as prior art, reconsideration and withdrawal of the outstanding rejection of the claims as being obvious is therefore requested without prejudice to later presentation of separate arguments of patentability over the subject matter of these references.

Conclusion

In view of the above remarks and amendments, it is respectfully submitted that the foregoing is fully responsive to the outstanding Office Action. Early favorable consideration of the above application is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any issues in the application, the Examiner is invited to contact said attorney at (651) 275-9811.

Respectfully Submitted,

Date: October 23, 2008

By: 

Dale A. Bjorkman, Reg. No. 33,084
Customer No. 33072
Phone: 651-275-9811
Fax: 651-351-2954